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10/698,046

5259-10800US01

Response to Office Action Dated September 18, 2006

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Applicants appreciate the time taken by the Examiner to review Applicants' present application. This application has been carefully reviewed in light of the Official Action mailed September 18, 2006. Applicants respectfully request reconsideration and favorable action in this case.

Pursuant to the restriction requirement under 35 U.S.C. § 121 and the telephone conversation between the Examiner and Beth Vrioni on September 6, 2006, Applicants elect without traverse to prosecute Group I claims 1-12, 21, 32-43 and 51. Claims 13-20, 65, 66, and 70 are withdrawn from consideration. Claims 22-31, 44-50, 52-64, and 67-69 are cancelled.

Rejections under 35 U.S.C. § 112

Claims 2-7 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

Claims 1-7 are amended to provide the necessary antecedent basis for the coupling mechanism. Accordingly, withdrawal of this rejection is respectfully requested.

Rejections under 35 U.S.C. § 102

Claim 21 is rejected under 35 U.S.C. § 102(e) as being anticipated by *Roger* (US Pat. 6,592,587).

Claim 21 recites "a flexible member for a spinal stabilization system" in the preamble. Furthermore, Claim 21, as amended, recites "a second section comprising a second stiffness and adapted for removable attachment to a head portion of a bone screw." In contrast, *Roger*'s guide wire is located on the threaded end of the screw (see, *Roger*, FIG. 4, Ref. 10, 14, and 20) and is used to penetrate two or more bones such that the screw can join the bones together (see, *Roger*, col. 7, lines 8-15). Thus, Applicants assert *Roger*'s use of a guide wire to join two or more bones does not anticipate Applicants' use of a flexible member coupled to the head of a screw used in spinal stabilization, and respectfully request the rejection be withdrawn.

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Rejections under 35 U.S.C. § 103

Claims 1-12, 21, 32-43 and 51 stand rejected as obvious over U.S. Patent No. 5,713,900 ("Benzel") in view of U.S. Patent No. 6,592,587 ("Roger").

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicants' disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Regarding claims 1-12, 21, and 32-42, Applicants assert the combination of *Benzel* in view of *Roger* does not make obvious the subject of Applicants' invention.

As an initial matter, Applicants respectfully submit that even if it is physically possible to combine the screw of *Roger* with the plates of *Benzel*, there would be no motivation to do so. More particularly, *Roger* discusses the use of a screw and guide wire in joining together bones at a fracture site with the guide wire penetrating the bones to be joined (see, *Roger* Figures 5a-5c). If combined with *Benzel*, the screws of *Roger* would not serve their intended purpose, but would merely act as anchors for the plates of *Benzel*. In this role, the guide wires of *Roger* would penetrate the vertebrae, posing unacceptable risks in spinal surgery. With reference to Figures 2 and 5 of *Benzel*, if the screws and guide wires of *Roger* replace the screws of *Benzel*, the guide wires of *Roger* would project into the center of the vertebrae, posing a risk that the guide wires would penetrate the spinal cord. Even if the screws were otherwise angled, there would still be an unacceptable risk that the guide wires would penetrate the spinal cord or an artery. Consequently, one of ordinary skill in the art would not use the screw and guide wire system of *Roger* to anchor the plates of *Benzel*. Because there is no motivation to combine the references as suggested by the Examiner, Applicants respectfully submit that the *prima facie* case of obviousness must fail.

Claim 1 recites that "the first flexible member and the second flexible member are guides for positioning the coupling mechanism at a desired position relative to the first threaded member and the second threaded member" and Claim 8 recites "a flexible member adapted for removable

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attachment to the first threaded member to position one or more additional components proximate to the first threaded member during use." Thus, in both Claim 1 and Claim 8, the flexible member(s) can act to position components relative to the respective threaded member(s).

Claim 21 recites "a second section comprising a second stiffness and adapted for removable attachment to a head portion of a bone screw" and Claim 32 recites that the first and second flexible members are coupled to the head portions of the respective threaded members. Because the flexible members of Claim 21 and Claim 32 couple to the head portions of the threaded members, the flexible members can extend generally away from the bone. This feature allows, for example, the flexible members to act as guides to the threaded members.

Roger, on the other hand, teaches a screw with the guide wire coupled to the threaded end portion of the screw, not the head portion. When in place, the guide wire acts as a guide for the threaded member and projects into the bone (see, *Roger*, col. 5, lines 38-45). Consequently, even if combined as suggested by the Examiner, the guide wire of *Roger* would extend into the bone from the threaded tip and could not act as a guide for other components, such as elements 10, 12, 14 of *Benzel*. Therefore, Applicants submit that Claims 1, 8, 21, and 32 are nonobvious in light of the cited references, and Applicants respectfully request allowance of these claims and their respective dependent claims.

In the Examiner's rejection of Claim 43 and 51, he states, *inter alia*, that *Benzel* discloses a ring, and cites Ref. 78 of Figure 4. The Examiner also states that Ref. 79 of Figure 4 is an opening. Applicants point out that Ref. 78 is merely an opening with axis 79. Because the Examiner has failed to point out where a ring such as that recited in Claims 43 and 51 can be found, the *prima facie* case of obviousness must fail. Accordingly, withdrawal of this rejection is respectfully requested.

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CONCLUSION

Applicants have now made an earnest attempt to place this case in condition for allowance. Other than as explicitly set forth above, this reply does not include an acquiescence to statements, assertions, assumptions, conclusions, or any combination thereof in the Office Action. For the foregoing reasons and for other reasons clearly apparent, Applicants respectfully requests full allowance of Claims 1-12, 21, 32-43, and 51. The Examiner is invited to telephone the undersigned at the number listed below for prompt action in the event any issues remain.

An extension of three (3) months is requested and a Notification of Extension of Time Under 37 C.F.R. § 1.136 with the appropriate fee is enclosed herewith.

The Director of the U.S. Patent and Trademark Office is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 50-3183 of Sprinkle IP Law Group.

Respectfully submitted,
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